

REMARKS

Claims 1-3, 7, and 9 are pending and under examination. The claims have been rejected under 35 U.S.C. 102 as anticipated by Cook et al. (US Pat. No. 5,554,646). The claims have been amended to further Applicant's business interests and the prosecution of the present application in a manner consistent with the PTO's Patent Business Goals (PBG; 65 Fed. Reg. 54603 (September 8, 2000)), and not in acquiescence to the Examiner's arguments and while reserving the right to prosecute the original (or similar) claims in the future. None of the claim amendments made herein are intended to narrow the scope of any of the amended claims within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) or related cases.

The Federal Circuit has stated the relevant analysis for anticipation as follows:

A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference.”¹

The Examiner argues that “Since the composition in the method of Cook et al. is exactly the same as the instant invention and used in the same proportions as the instant invention, the subjects receiving the composition of Cook et al. would have inherently had the benefit of hypertension treatment and lowering of blood pressure. It is the Examiner’s position that the “use” of linoleic acid to treat hypertension is directed to a property of linoleic acid and therefore the claims are anticipated. See *In re May*, 574 F. 2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978). *Ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993).”

Applicants respectfully submit that the cited case law does not support the Examiner’s position. In *In re May*, the claims were rejected as obvious. *May*, 574 F.2d at 1090. The prior art disclosed the use of the compounds for analgesia. *Id.* The invention was directed to a method of inducing nonaddictive analgesia. *Id.* The Court found that this was not a new use, i.e., both methods were for effecting analgesia. *Id.* In contrast, in the instant case, the use of treating hypertension is not the same as the use described in Cook, i.e., reducing body fat.

Likewise, *Ex parte Novitski* does not support the Examiner’s rejection. *Novitski* is a Board of Patent Appeals and Interferences case in which an obviousness rejection was

Verdegaal Bros. V. Union Oil Co. Of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

overturned by the Board and an anticipation rejection was entered. The claims were subsequently **allowed** by the Patent Office in U.S. Pat. No. 5,264,210. Claim 1 in the patent reads as follows: A method for protecting a plant from a plant pathogenic nematode species which comprises the step of inoculating said plant with a strain of *P. cepacia* which strain colonizes said plant, and which strain is effective to immobilize at least about 40% of said nematodes in in vitro agar plug assays. Thus, *Novitski* does not appear to be binding precedent. The USPTO allowed the claims to use for nematode resistance even though the prior art allegedly taught use for fungal resistance. The claims in the instant application are similarly distinguishable from the prior art. Use for treatment of hypertension is a new use as compared to use to reduce body fat.

Applicants respectfully submit that the controlling case is actually *In re Shetty*, 556 F.2d 81, 195 USPQ 753 (CCPA 1977). In *Shetty*, the claims were directed to the use of adamantane derivatives to curb appetite. *Id.* at 81. The prior art taught the use of the same compounds antiviral agents in animals. *Id.* at 83. Judge Rich found that the rejection of the method claims was improper. *Id.* at 86. As Judge Rich found:

That appellant's "amount effective to curb appetite" corresponds to or inheres in Narayanan's amount "to combat microbial infestation" does not persuade us of the obviousness of appellant's method. As this court said in *In re Naylor*, 54 CCPA 902, 905-06, 369 F.2d 765, 768, 152 USPQ 106, 108 (1966):

[Inherency] is quite immaterial if, as the record establishes here, one of ordinary skill in the art would not appreciate or recognize that inherent result.

* * *

we find nothing in the record which would afford one of ordinary skill reason to anticipate that a trial

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[of the combined prior art teachings] would be successful in producing the polymer recited in the claims.

The Patent Office has failed to show a reasonable expectation, or some predictability, that Brake's compound would be an effective appetite suppressant if administered in the dosage disclosed by Narayanan. The mere hindsight assertion that corresponding dosages render appellant's method obvious is untenable. Prior to appellant's disclosure, none of the adamantane compounds in any of the references before us suggested a use, much less a dosage, for curbing appetite. What we said in *In re Spormann*, 53 CCPA 1375, 1380, 363 F.2d 444, 448, 150 USPQ 449, 452 (1966), relative to inherency applies equally here:

As we pointed out in *In re Adams*, 53 CCPA 996, 356 F.2d 998, 148 USPQ 742 [(1966)], the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.

Thus, inherency is immaterial if one of ordinary skill in the art would not appreciate or recognize the allegedly inherent result.

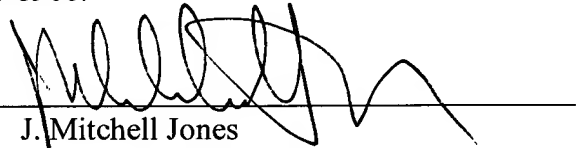
With respect to the instant claims, the Examiner has not shown that Cook et al. or the prior art appreciated or recognized the result of treating hypertension. As such, the Examiner's rejection clearly does not comport with established precedent, and in particular the holding of *Shetty*.

Applicants have claimed a process comprising a new use of CLA. 35 U.S.C. § 100 specifically provides that the term "process" means, *inter alia*, "a new use of a known . . . composition of matter, or material". The Examiner has not provided prior art disclosing the claimed use. Accordingly, the Examiner's anticipation rejection should be withdrawn.

CONCLUSION

It is respectfully submitted that the invention as claimed fully meets all requirements for patentability and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

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